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Atty. Docket No.: 18433/2042 PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Rance, et al.  
Serial No.: 09/963,803  
Filed: September 26, 2001  
Titled: Chimeric Expression Promoters  
Originating from Commelina Yellow  
Mottle Virus and Cassava Vein Mosaic  
Virus

Examiner: D.M. Sullivan  
Group Art Unit: 1636  
Conf. No.: 9170

**CERTIFICATE OF MAILING UNDER 37 CFR 1.10**

I hereby certify that the paper (and any paper or fee referred to as being enclosed) is being deposited with the United States Postal Service using Express Mail to Addressee Service, under 37 C.F.R. Section 1.10, Express Mail Label No. EL928101967US on this date, **March 27, 2003**, postage prepaid, in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231.

Kathleen M. Williams

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Commissioner for Patents  
Washington, D.C. 20231

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**RESPONSE TO RESTRICTION REQUIREMENT**

APR 03 2003

Dear Sir:

TECH CENTER 1600/2900

In response to the Restriction Requirement dated September 27, 2002, Applicants elect Group IV, Claims 1-42; promoters MPr1162, MPr1163, and MPr1165 for prosecution on the merits, with traverse.

Applicants wish to thank the Examiner for the telephone discussion of the restriction requirement with Applicant's agent on March 25, 2003. Pursuant that conversation, Applicants present the following arguments in support of their request for rejoinder of the inventions set forth in Groups IV and VI.

The Examiner asserts that the claims are drawn to products and methods comprising patentably distinct chimeric expression promoters. The Examiner asserts that this distinctness is based on the fact that the promoters of each restricted group comprise distinct sets of functional elements. With respect to Groups IV and VI, Applicants submit that the promoters which have been placed into each of these two groups do, in fact, overlap in the specific sequence (as2-as2-as1) of functional elements. Each promoter sequence in the two groups shares the same basic

sequence element as2-as2-as1. Thus, each of the promoter in Groups IV and VI is related to each other promoter in the group.

Accordingly, a search of that sequence element would necessarily identify any sequences relating to the elected promoters. It would seem that even if such a search returned a number of hits representing a subset of the sequence database, it would be much easier to search the entire specific promoter sequences against a subset of the sequence database rather than the entire database.

The MPEP (803.04) clearly states that the PTO is willing to examine up to 10 distinct nucleic acid sequences presented in a given application. Applicants submit that where the U.S. PTO has clearly provided that up to 10 sequences may be examined in a single application, and given the overlap of the sequence motifs of the promoter sequences in Groups IV and VI, that it would pose no undue search burden on the Examiner to examine the six promoter sequences encompassed by Groups IV and VI.

In addition, the claims of each of the restricted groups have been placed in the same class and subclass. Where the related inventions as claimed are shown to be distinct under the criteria of MPEP §806.05(c) - §806.05(i), the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

- (A) Separate classification thereof . . . .
- (B) A separate status in the art when they are classifiable together . . . .
- (C) A different field of search . . . .

Where, however, the classification is the same, and the field of search is the same, and there is no clear indication of separate future classification and field of search, no rationale exists for dividing among related inventions.

The claims in all six groups have been placed in the identical class and subclass. Contrary to the requirements for imposing a restriction requirement when claims are so

classified, the claimed inventions do not appear to have acquired a separate status in the art, nor has any evidence been presented to show that any of the inventions of Groups I-VI would necessitate a search in an area where no art pertinent to the other Groups exists. This rationale, coupled with the lack of an undue search burden supports Applicant's traversal of this restriction, at the very least with respect to Groups IV and VI, but also with respect to the restriction requirement as a whole.

Accordingly, Applicants request that the sequences restricted into Groups IV and VI be rejoined and examined together in the present application.

Applicants are filing herewith a Petition for Extension of Time, and appropriate fee, to extend the period of response in this case up to and including March 27, 2003. Applicants hereby authorize the Commissioner to charge any additional fees to Deposit Account No. 16-0085, reference no. 18433/2042.

Respectfully submitted,



Date: March 27, 2003

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